REMARKS

Claims 1 through 24 are pending in this application. Claims 8 is amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

I. Examiner's response to Arguments

The Examiner stated in paper number 22 that the Applicant argues that the cited references do not teach or suggest an indicator that is displayed and used to select the menu and can be adjusted to be located within the submenu. In response the Examiner states that Sakurai (USPN 5581685) teaches the display of current menu (S28), the selection for displaying a sublevel menu (S29 or a step S31) and a selection process that may be performed by control code keys, function keys etc. See col. 2, lines 64-67 and col. 3, lines 1-13.

However, this disclosure is of the prior art that Sakurai is teaching away from. As mentioned in col. 3, lines 25-50, Sakurai mentions the flaws of the prior art in steps 21-34 mentioned in cols. 2 and 3 of Sakurai and the need for changes in the disclosure mentioned by the Examiner above.

A reference may be said to <u>teach away</u> when a person of ordinary skill, upon reading a reference , would be discouraged from following the path set out in the reference, or would be <u>led in a direction divergent from the path that the applicant took</u>. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Therefore, after reading the disclosure relied upon the Examiner and the Sakurai as a whole, a person of ordinary skill in the art would be discouraged from following

such a path.

The Examiner further states that Choi also teaches step (110) in which the cursor is located by a user on an intended main menu icon and discloses a submenu selection and display step (130). See Fig. 1. Furthermore the Examiner states that one should see Choi's Fig (2c ... 2G) showing the movement, the display and relocation of a cursor (32) for steps (100 .... 180) respectively.

However, the disclosure in step 110 and the relocation of the cursor is performed by the user's manual movement of the cursor. As mentioned in col. 3, lines 14-16, "Step 110 is a step in which the cursor is located by a user on an intended main-menu icon by controlling the trackball." Further, concerning the submenu, Choi states "Step 140 is a step in which the desired icon of the sub-menu displayed in step 130 is selected. Here, the cursor 32 is moved based on the same principle as in step 110 onto a sub-menu icon ...as shown in Fig. 2D." Therefore, it is clear, that Choi is only mentioning the manual movement by a user for the movement of the cursor in the menu and also in the sub-menu.

Therefore, neither Choi nor Sakurai alone or in combination teach or suggest *automatically adjusting the position of said indicator to be located within said sub menu.*

The Examiner states that the Applicant argues that the cited references do not teach storing the location of the menu item that was selected. The Examiner argues that Sakurai teaches that the file names of a submenu is stored in a display-file-name storage area allocated in a memory. See col.

9, lines 42-47 and Fig. 12 (S12).

However, the Applicant is not just merely arguing that Sakurai is not teaching or suggesting the storing of the menu item, but arguing that Sakurai fails to teach or suggest the storing of the location of the menu item with regard to the selection of a menu item displayed within the display screen by moving the indicator. For example, claim 4 states *making a selection of a menu item displayed within said display screen by moving said indicator around said menu to said menu item;storing a location of said menu item in reference to said menu area.* The whole claim must be looked at as a whole and not just pieces put together. Another example is claim 8 which states *storing a location of said menu item which was selected.* Therefore, Sakurai or the combination of references do not teach or suggest storing of the location of the menu item that was selected. The Examiner mentions lines col. 9, lines 42-47 and Fig. 12 (S12) which states "As the same time, the file name of the submenu is stored in a display-file-name storage area allocated in a memory." Sakurai is storing the "file names" and not the *location of said menu item which was selected.*

The Examiner also states that Choi discloses menu display storage unit (70) storing menu items as well as submenus and controlling mode displays. See col. 4, lines 22-34.

However, looking at col. 4, lines 22-34, the context of the storage unit 70 is that the menu key displays various menus and then the next sentence states "Here, menu display storage unit 70 also stores the submenus and control mode displays as well." From this context, it shows that the storage unit is only a storage for entire menu structure and submenu structure but clearly not *storing*

a location of said menu item which was selected as mentioned in claim 8 for example.

Moreover, the Examiner states that Choi teaches the use of shift value data storage in terms of selection of a predetermined control contents of the menu icon displayed on the screen where the cursor is located. See col. 1, lines 40-48.

However, looking at Choi in col. 1, lines 40-48, states that "A data generating means for generating data corresponding to the shift value data stored in the shift value data stored in the shift value data storage unit is coupled to a transmitting means for coding and transmitting the data of the data generating means to a predetermined receiver, as is a control commander which is used to select the predetermined control contents of the menu icon displayed on the screen where the cursor is located." This is the description from the summary of the invention of Choi.

The actual detailed description of above in col. 4, lines 22-35 of Choi is the following, "In order to select an icon displayed on the screen of television 52, trackball 54 is operated, e.g., in a positive or negative X-axis direction and in a positive or negative Y-axis direction so that cursor movement is generated. In trackball movement sensor 56, the movement of trackball 54 is sensed as a position shift value. In shift value data storage unit 58, *data with respect to the position shift values are stored in advance.* Data generator 60 generates the data corresponding to the sensed position shift value from shift value data storage unit 58. Then, control commander 62 selects the menu icon which is displayed on the screen where the cursor is located. Finally, transmitter 64 codes and transmits the data generated by data generator 60."

Therefore, as seen above, Choi is not teaching or suggesting *storing a location of said menu*

item which was <u>selected.</u> It states in Choi that *data with respect to the position shift values are*

stored in advance and therefore there is no teaching or suggestion of storing the location of the menu

item which was selected.

II. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1 through 24 were rejected under 35 U.S.C. §103(a) as being unpatentable.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness

under 35 U.S.C. §103:

> To establish a *prima facie* case of obviousness, three basic criteria
>
> must be met. First, there must be some suggestion or motivation,
>
> either in the references themselves or in the knowledge generally
>
> available to one of ordinary skill in the art, to modify the reference or
>
> to combine reference teachings. Second, there must be a reasonable
>
> expectation of success. Finally, the prior art reference (or references
>
> when combined) must teach or suggest all the claim limitations. The
>
> teaching or suggestion to make the claimed combination and the
>
> reasonable expectation of success must both be found in the prior art
>
> and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20
>
> USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 1-3 and 18-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai (U.S. Patent 5,581,685) in view of Choi (U.S. Patent 5,648,781). The Applicant respectfully traverses.

Regarding claims 1, 18 and 21, the Examiner states that Sakurai teaches about displaying a menu, and submenu with area indicators. See Column 9, line 46-56, and Fig. 13A. The Examiner also states that Sakurai discloses an area indicator which is increased or decreased by one for a display of submenu and for a display of previous menu respectively. See column 9, lines 47-57.

However, the indicator in Sakurai is not used for selecting an item of a menu but is an internal pointer that has its value automatically increased or decreased by a management program.

The Examiner points to col. 9, lines 46-56 of Sakurai as disclosing an area indicator which is increased or decreased by one for a display of submenu and for a display of a previous menu. Col. 9, lines 46-56 refers to figure 13A. As seen in col. 5, lines 22-23, in the description of figure 13A "figures 13A to 13D are illustrative drawings of a **display-file-name storage area for storing a menu history.**"

The area indicator is not being used to select a menu item and it is not displayed to a user for selection of the menu. The figures 13A-13D and the description in col. 9, lines 47-57 is dealing with the storage area and clearly, the area indicator of Sakurai is only an internal pointer that only concerns the internal workings of Sakurai. On the other hand as seen in claim 1 for example of the present invention, the indicator is displayed and is used to select.

Sakurai also does not teach or suggest the displayed indicator which is used to select, also

adjusting to the position of the submenu when the submenu is chosen. An "area indicator is .

incremented by one each time a new submenu is dispayed" (col. 9, lines 50-51) is not teaching or

suggesting *adjusting the position of said indicator to be located within said sub menu.* Clearly the

description in col. 9, lines 50-51 is the language describing an internal pointer in a storage level

system. The internal pointer of Sakurai is not physically shown to be moving to the new submenu.

There, then Sakurai also does not teach the relocation of the displayed indicator back to the menu

item when the submenu is erased.

The Examiner does state that *Sakurai* does <u>not</u> *teach automatically adjusting the area*

indicator to be located within the submenu. However, the Examiner states that Choi teaches of

locating a cursor (32) on the desired submenu icon. For example, a cursor appearing on a main menu

icon (30) is relocated and displayed on a submenu (34). See col. 3, lines 14-26 and Fig. 2(C-D).

However, looking at Choi, the cursor is manually moved at all times and there is no

automatic adjusting of the cursor to be located within the submenu. As mentioned above, the

disclosure in step 110 and the relocation of the cursor is performed by the user's manual movement

of the cursor. As mentioned in col. 3, lines 14-16, "Step 110 is a step in which the *cursor is located*

by a user on an intended main-menu icon by controlling the trackball." Further, concerning the

submenu, Choi states in col. 3, lines 28-32, "Step 140 is a step in which the desired icon of the sub-

menu displayed in step 130 is selected. Here, the cursor 32 is moved based on the same principle ·

as in step 110 onto a sub-menu icon ...as shown in Fig. 2D." Therefore, it is clear, that Choi is only mentioning the *manual movement by a user* for the movement of the cursor in the menu and also in the sub-menu and not an automatic movement as the claims of the present invention teach.

Furthermore, the manual movement of the cursor by Choi is teaching away from any type of automatic movement since it says the *cursor is located by a user*.

Regarding claim 2, Choi teaches a cursor being displayed on a menu and submenu as shown in Fig. 2C and 2D respectively. The Examiner further states that Choi teaches when a menu key is pressed, a main menu is displayed on a system monitor such that the cursor is initially located at a predetermined screen location. See Fig. 1 (100) and col. 3, lines 4-13.

Choi only teaches of cursor being initially located at a screen location but no mention of being at the menu. Figures 2C and 2D on col. 2, lines 24-29 on state that they show the display state of a televison screen but no indication that it is the initial state. In fact 2C in col. 2, lines 21-26 state "For example, if the main-menu icon "screen status" is selected in steps 110 and 120, the sub-menu displayed in step 130 may include sub-menu icons 34 such as "BRIGHTNESS," "CONTRAST," "SHARPNESS" and "TINT," as shown in FIG. 2C." Concerning figure 2D, in col. 3, lines 28-32, · Choi states, "Step 140 is a step in which the desired icon of the sub-menu displayed in step 130 is selected. Here, the cursor 32 is moved based on the same principle as in step 110 onto a sub-menu icon controlling, for example, screen brightness, as shown in FIG. 2D."

Therefore, figures 2C and 2D are not showing an initial state, but when the main-menu is

selected for figure 2C to display the sub-menu, and when the sub-menu selected in figure 2D.

Furthermore, looking at figure 2C, one can see that the cursor 32 is <u>still on the main menu</u> and not on the sub-menu 34 as defined in Choi when the main menu item is selected to display the sub-menu. Therefore, in Choi, when menu 30 is selected, then submenu 34 is displayed, however, the cursor 32 remains at the main-menu location. In figure 2D, the only reason the cursor is finally on the submenu is because it is moved by the user according to step 110 of Choi in order to select a submenu item.

Therefore, Choi is teaching away from the present invention and should not be combined with Sakurai. Further, therefore, nothing in either Choi or Sakurai teaches or suggests of *automatically adjusting the position of said indicator to be located within said sub menu* as mentioned in claim 1. As mentioned above, the Examiner agrees that Sakurai does not teach or suggest of *automatically adjusting the position of said indicator to be located within said sub menu* and as shown above, the Applicant has shown that Choi also does not teach of *automatically adjusting the position of said indicator to be located within said sub menu* but teaches away by the user having to move the cursor as mentioned for example in claim 1 of the present invention.

The Examiner states that regarding claims 3, 19-20 and 22-23, Choi teaches the use of a remote controller (50), cursor movement from menu to submenu (Fig. 2C, 2D), operation of an enter installed in the remote controller (col. 2, lines 1-5) and the storage of menu (700) as shown in Fig.

3.

Choi does not teach or suggest *the indicator being located in the first sub menu item* as mentioned in claim 19. Choi in figure 2C and 2D as mentioned above shows only that when the menu item is selected to display the submenu, the indicator is not located to the submenu (Figure 2C) and especially not in the first submenu item as mentioned in claims 18 and 19. Figure 2D shows the cursor at the first submenu but that is only after manual movement of the cursor from the menu item in figure 2C to the submenu item is figure 2D when the user is ready to select the sub-menu item.

Regarding claim 24, the Examiner stated that the Applicant should see Choi's Fig. 3. (58, 70).

Claim 24 teaches of *storing a location of the selected menu item within a display screen; and automatically adjusting the display of said indicator to the stored location of the selected menu item when said sub menu is erased.* Reference 58 of Choi is the shift value register which only stores the movement of the cursor. Reference 70 is the menu storage which only has the stored menu items but never in Choi is it stated that when selection is made that it is then there is a storing a location of the selected menu item. Furthermore, nowhere in Choi is it shown that when the selected submenu item is erased, that the indicator is automatically located to the stored location of the selected menu item. As mentioned above, according to figures 2C and 2D of Choi, the cursor remains on the menu item when the menu item is selected to display the submenu.

Concerning motivation to modify the references, the Examiner stated that it would have been obvious to one skilled in the art at the time the invention was made to modify Sakurai's menu display

system to adapt Choi's cursor movement within a menu as shown in Fig. 2(C-D) because one would

have been motivated in view of the suggestion that the cursor movement provides the desired

adjustment of an area indicator within a menu. The Examiner states that the use of cursor movement

helps locate the desired submenu as taught by Choi.

The first point in MPEP 706.02(j) states that there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill

in the art, to modify the reference or to combine reference teachings. "Combining prior art references

without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure

as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994,

50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be "clear and particular" without broad

generalized conclusory statements. *Id.* There must be specific statements showing the scope of the

suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be

an explanation to what specific understanding or technical principle would have suggested the

combination of references. *Id.* However, here the reasoning is a general conclusory statement that

is not clear and particular. Furthermore, as shown above, both Choi and Sakurai teach away from

the combination of the two references.

**B. Claims 4-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over
Sakurai (U.S. Patent 5,581,685) in view of Choi (U.S. Patent 5,648,781) and in further view of
Miyashita (U.S. Patent 6,186,630). The Applicant respectfully traverses.**

Regarding claims 4, 8, 17, the Examiner in paper number 22 states that Sakurai teaches that

the file name of a submenu is stored in a display-file-name storage area allocated in a memory. See

column 9, lines 42-47, and Fig. 12.

However, the file name of the submenu and menu is not the same as *storing a location of*

said menu item in reference to said menu area. The location of the menu item with reference to the

menu area is not taught or suggested by storing mere file names.

Moreover, the Examiner states that Sakurai teaches that selection can be made using function

keys in order to control the pages of the menu on a screen. See Column 9, line 24-30, line 42-46, line

57-63, and Fig. 12.

However, this does not teach or suggest the *making a selection of a menu item displayed*

within said display screen by moving said indicator around said menu to said menu item as

mentioned for example by claim 4. Selection of the menu item by moving the indicator to the menu

item is not taught or suggested by function keys merely controlling the pages of the menu screen.

Further, the Examiner mentions that Sakurai also teaches of displaying submenus (S29, S31)

and their corresponding selection processes (S30, S32). See Fig. 3.

However, Sakurai is not teaching steps S29-32 of figure 3 because as seen in col. 4, lines 64-

65, "FIG. 3 is a flow chart of exemplary processing of another hierarchical-structure menu system

of the *prior art*." Sakurai is teaching away from the old art shown in figure 3 as mentioned explicitly

in cols. 2 and 3 of Sakurai which mentions of the flaws of figure 3.

Regarding claim 17, the Examiner states that referring to Fig. 3, Choi teaches of a remote controller (50) including a trackball (54), a trackball movement sensing means (56) for sensing the movement of the trackball (54) as position shift value, a shift value data storage unit (58)for storing data with respect to the position shift values in advance.

However, claim 17 mentions that the shift value data is corresponding to the movement of said trackball relative to the initial indicator position. In Choi, the movement is not relative to the initial indicator position. Choi unlike the present invention, stores in advance the position shift values in the shift value data storage unit .

Regarding claims 5, and 14, the Examiner states that Choi teaches a cursor being displayed on a menu and submenu as shown in Fig. 2C and 2D respectively. However, Choi does not exhibit any change in the position and size of the menu so that indicator automatically follows the menu and mentioned in claims 4 and 5. As shown above, in Choi, in figure 2C and 2D, the cursor is always manually moved.

Regarding claims 9-10, the Examiner states that Miyashita teaches about a projection system where the position of the pointer can be controlled apart from main control means and Miyashita further teaches that an operator can freely control the display position of the position mark by operating a hand-held remote controller. See Column 1, line 52-56, and Column 3, 5-10.

However, this explanation does pertain to the language in claims 9 and 10 which state *said*

indicator is initially located in the center of said first menu item for claim 9 and *after erasing said*

sub menu, said indicator locates back to a center of said stored location of said menu. Miyashita,

Choi or Sakurai or the combination do not teach or suggest of the indicator being initially located

at the center of the first menu or after erasing said submenu, the indicator locating back to the center

of the stored location of the menu. Freely controlling as Miyashita mentions is teaching or manual

movement and not of locating a particular area to aid the user in manipulating the menus and

submenus.

Concerning the motivation to combine Miyashita with Choi and Sakurai, the Examiner states

that it would have been obvious to one having skill in the art at the time the invention was made to

replace Sakurai's Keyboard (7) by Miyashita's remote controller (20) for the purpose of entering data.

Therefore, the Examiner states that one would have been motivated in view of the suggestion in

Miyashita that the remote controller (20) is equivalent to the desired remote controller for controlling

the movement of an indicator.

However, this motivation in Miyashita does not explain the other uses in Miyashita in the

rejections above. Simply having one common part that is mentioned to be replaceable is not a proper

motivation to modify. For instance, this reasoning does not show how the Miyashita should be

combined with Choi and Sakurai concerning *said indicator is initially located in the center of said*

first menu item for claim 9 and *after erasing said sub menu, said indicator locates back to a center*

of said stored location of said menu for claim 10. The motivation must be particular and clear. As

mentioned above, Miyashita is teaching away from the present invention by teaching of free

movement and no teaching of locating the indicator to a particular position as claims 9 and 10 mention.

III. New grounds for rejection -removal of final rejection

In paper number 22, the Examiner imposed new grounds for rejection. The new grounds for rejection are evidenced by the following:

1. on page 2 of paper number 22, the Examiner uses Sakurai (USPN 5581685) teaching the display of current menu (S28), the selection for displaying a sublevel menu (S29 or a step S31) and a selection process that may be performed by control code keys, function keys etc. See col. 2, lines 64-67 and col. 3, lines 1-13. The above argument is from the background art of Sakurai which was never mentioned in the last office action of paper number 20.

2. On page 3 of paper number 22, the rejection includes a 35USC§103 rejection of claims 1-3 and 18-24 based on Sakurai (USPN 5,581,685) and Choi (USPN 5,648,781) and a separate 35USC§103 rejection of claims 4-17 based on Sakurai, Choi and also Miyashita. However, in the previous office action of paper number 20, the rejections included only a 35USC§103 rejection of claims 1-23 based on Sakurai, Miyashita and Choi.

Furthermore, the new grounds of rejections were not necessitated by the amendment. As the amendments of 3, 8 and the addition of claim 24 do not relate to the above new grounds in the rejection.

For example in paper number 20, the Examiner mentioned specifically Sakurai and Miyashita concerning claim 1 which was not amended and the present office action of paper number 22, the Examiner used Sakurai and Choi instead.

In another example, concerning claim 1 which was not amended in any way, the Examiner in paper number 22 stated that Sakurai does not teach automatically adjusting the area indicator to be located within the submenu but that Choi teaches locating a cursor (32) on the desired submenu icon. For example, a cursor appearing on a main menu icon (30) is relocated and displayed on a submenu (34). See col. 3, lines 14-26 and Fig. 2(C-D). This ground of rejection was not made earlier in paper number 20.

Another example is claim 17 which was not amended, the Examiner stated that "Choi teaches the use of a remote control method for performing remote controlling of a television in which menu icons having predetermined control contents are utilized. Choi teaches the use of main menu, submenu, and the cursor that are displayed on the screen of the television (col. 1, lines 48-57). Choi further teaches displaying the menu icons and selecting the desired menu icon as well as displaying cursor on the screen and the cursor being initially displayed on a predetermined position of the screen according to the X, Y coordinates. See col. 1, lines 49-67. Moreover, referring to Fig. 3, Choi teaches a remote controller (50) including a trackball (54), a trackball movement sensing means (56) for sensing the movement of the trackball (54) as position shift value, a shift value data storage unit (58)for storing data with respect to the position shift values in advance, control commander (62) for selecting the menu icon which is displayed on the screen where the cursor is located, data generator (60) for generating the data corresponding to the sensed position shift value from shift value data

storage unit (58) and transmitter (64) for coding and transmitting the data generated by data generator (60). Choi also teaches a television (52) including a receiver (66) for receiving the signal transmitted from the transmitter (64), menu display circuit (68) for displaying various menus of the television and the menu storage (70) for storing menus, submenus and control modes, a cursor display circuit (72) for displaying the cursor according to the movement of the trackball and content execution unit (74) for executing the function of the selected icon where the cursor is located."

None of the above ground for rejection was mentioned before paper number 22.

Many other examples of new grounds for rejections that were not necessitated by amendment can be shown.

Therefore, because of the new grounds of rejection that were not necessitated by amendment, the Examiner must remove the finality of this rejection.

IV. IDS PTO-1449

The applicant appreciates receiving on 6 October 2003, PTO-1449 acknowledging the consideration of the four (4) documents from an IDS filed on 1 April 2002. However, the Applicant is concerned about the IDS not being considered until 5 October 2003, a full year and a half after it was filed and since the Applicant diligently reminded the Examiner in the previous responses of paper number 19 filed on 14 November 2002, paper number 21 filed on 22 April 2003, and telephone calls. In paper number 22 mailed on 4 August 2003, the Examiner noted that paper number 13 which is PTO-1449 form is attached, but no such paper was attached and yet the date of

consideration is signed as 5 October 2003. As stated in MPEP§609, "Once the minimum requirements of 37 C.F.R. §1.97 and 37 C.F.R. §1.98 are met, the examiner has an obligation to consider the information." The requirements of 37 C.F.R. §1.97 and 37 C.F.R. §1.98 were met by 1 April 2002.
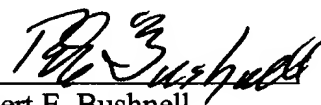
V. Entry of the Amendment

Entry of the foregoing amendment to claim 8 is proper under 37 C.F.R. 1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, and explanations, could not have been made earlier because they are merely responsive to issues newly raised in Paper No. 22.

Specifically, Claim 8 was amended only for placing in proper form with no substantive change.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should

other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of

Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P55862
Date: 22 October 2003
I.D.: REB/SS